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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/771,081

02/04/2004

Jon Muskin

MUS-02

1948

43536 7590 01/10/2007

MUSKIN & CUSICK LLC

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SUITE 200

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EXAMINER

HU, KANG

ART UNIT

PAPER NUMBER

3709

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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31 DAYS

01/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/771,081

Applicant(s)

MUSKIN, JON

Examiner

Kang Hu

Art Unit

3709

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10 and 27, drawn to a method of associating monetary ticket with targeted slot machine, customer, and time period. An apparatus for associating the targeted slot machine with a slot machine database and comparing slot machine type classified in class 463, subclass 25.
 - II. Claims 11-13, drawn to a method of having a cashable and a noncashable portion for the monetary ticket, classified in class 463, subclass 25.
 - III. Claims 14-19, drawn to a method of assigning monetary ticket a dollar amount playthrough requirement and either issuing a new updated playthrough requirement or a standard ticket after the requirement has been met, classified in class 463, subclass 25.
 - IV. Claims 20-22, drawn to a method of assigning monetary ticket with a special payable, classified in class 463, subclass 25.
 - V. Claim 23, drawn to a method of triggering a special software routine if the ticket indicates special promotional mode, classified in class 463, subclass 25.
 - VI. Claim 24, drawn to a method of not disclosing actual dollar amount to the customer until the monetary ticket has been inserted into the machine, classified in class 463, subclass 30.
 - VII. Claim 25, drawn to a method of assigning special promotional ticket based on player's history and predetermined criteria, classified in class 463, subclass 25.

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- VIII. Claim 26, drawn to a method of downloading a downloadable software module upon verification of compatibility with particular game, classified in class 463, subclass 43.
- IX. Claim 28, drawn to a ticket redemption apparatus with a determining unit to determine if the ticket has met proper conditions for cashout, classified in class 463, subclass 43.
- X. Claims 29-32, drawn to a ticket marketing apparatus with a marketing database, random fortunes for ticket message associating with targeted slot machine and time frame, classified in class 463, subclass 43.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II through X are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the features described in the subcombination such as cashable and noncashable portion, playthrough requirement, special payable, special promotional mode, not-disclosing the dollar amount on the ticket, special promotion selection, downloading software module, determining unit for ticket reader and ticket marketing apparatus are different features for game play. The subcombination has separate utility such as casino coupon ticket with cashable and non-cashable portion, scratch off tickets where the player purchases multiple plays, casino

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gaming machine with special pay table, networked slot machine for special promotion, computer games that download software modules, credit/debt card machine that determines the validity and amount currently available for withdraw, and marketing system for bill board advertisement that displays random messages.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

3. A telephone call was made to Jon Muskin on January 3rd 2007 to request an oral election to the above restriction requirement, but did not result in an election being made.

4. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kang Hu whose telephone number is (571)270-1344. The examiner can normally be reached on 8-5 (Mon-Thu).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk(James) Lee can be reached on 571-272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KH/
Kang Hu
Jan 3rd, 2007


KIM NGUYEN
PRIMARY EXAMINER